

Remarks

This Amendment is in response to the Office Action dated **November 27, 2006**. The Office Action: **1)** objected to Specification for failing to provide antecedent basis for claimed subject matter, **2)** objected to claim 42 for failing to include a comma, **3)** rejected claim 47 under 35 U.S.C. §102(e) by US 5,609,627 (hereinafter Goicoechea) and under 35 U.S.C. §103(a) by Goicoechea alone, **4)** rejected claim 48 under 35 U.S.C. §102(e) by Goicoechea and under 35 U.S.C. §103(a) by Goicoechea alone, **5)** rejected claims 34, 35, 37, 42-45, and 47 under 35 U.S.C. §103(a) over US 5,421,955 (hereinafter Lau) in view of US 5,843,117 (hereinafter Alt) and over Lau in view of US 6,027,526 (hereinafter Limon), and **6)** maintained a previous rejection over claim 49 under 35 U.S.C. §102(e) by Goicoechea. The following comments are presented in the same order as in the Office Action with section numbers corresponding to the above enumeration.

1) Specification Objection

The Specification was objected to for failing to provide antecedent basis for the claimed flow path. As was made clear in Applicant's September 18, 2006 Amendment, antecedent basis for a tapered flow path can be found in the application on page 2 lines 10-12, page 4 lines 6-8, page 15 lines 4-17, and page 17 lines 4-5 of the. However in order to further facilitate the prosecution of this matter applicant has amended the paragraph located at originally filed page 17 line 7 to further antecede the tapered flow path. Per the Examiner's suggestion, the actual claim language is now present in the Specification. No new matter has been added as the tapered flow path was described on the previously mentioned pages.

2) Objection to punctuation in claim 42

Claim 42 was objected to for not including a comma after the word "diameter". The instant claims recite the suggested punctuation change.

3) Rejection of claim 47 under 35 U.S.C. §§ 102(e) and 103(a) by Goicoechea

The Office action rejected claim 47 under 35 U.S.C. §§102(e) and 103(a) by Goicoechea. As Applicant stated in the September 18, 2006 Amendment, claim 47 recites an

annular element with a greatest tapered diameter having no more interconnected struts than the annular element with a narrowest tapered diameter. Nowhere in Goicoechea is this limitation disclosed. In response to the September 18, 2006 Amendment's argument, the Office Action stated that this is not persuasive because claims 48 and 49 do not also contain this limitation. Applicant respectfully notes that claims may not be rejected by association and a purported defect in some other claim is not a legitimate basis for rejecting a given claim independent from the purportedly defective claim. Because claim 47 does not depend from either of claims 48 and 49, the Office action's basis of rejection is without merit or validity and does not meet the burden of proof required to sustain either anticipation or obvious based rejections.

4) Rejection of claim 48 under 35 U.S.C. §§ 102(e) and 103(a) by Goicoechea

Instant claim 48 has been amended to recite an annular element with a greatest tapered diameter having no more struts than the annular element with a narrowest tapered diameter. Nowhere in Goicoechea is this limitation disclosed. In addition to traversing Goicoechea, this amendment does not require a new search as this limitation has already been presented and searched for by the prosecution of claims 34-35, 37, 42-45, and 47. This amendment merely limits the scope of already searched for material. For at least these reasons the §102(e) and § 103(a) rejections are traversed.

5) 35 U.S.C. § 103(a) Rejection of claims 34, 35, 37, 42-45, and 47 under Lau in view of Limon and Lau in view of Alt

The Office Action rejected claims 34, 35, 37, 42-45, and 47 under 35 U.S.C. §103(a) over Lau in view of Limon and alternatively over Lau in view of Alt. These claims all recite a stent which has a tapered configuration in the expanded state. The tapered balloon stent described in Lau in contrast does not have an expanded state as the term "expanded state" is used and defined in the specification.

The terms used in the claims should be construed according to their use and definition in the specification because an applicant is entitled to be his or her own lexicographer (*See In re Paulsen*, 31 U.S.P.Q.2d 1671, 30 F.3d 1475, 1480 (Fed. Cir. 1987), as well as MPEP § 2173.05(b)). This is because the specification is what gives meaningful notice to the public and

provides a clear and consistent meaning to the claims. Phillips v. AWH Corp., 75 U.S.P.Q.2d 1321, 415 F.3d 1303, 1313 (Fed. Cir. 2005). This is the case even when the specification does not recite an explicit definition. Id. citing SciMed Inc. v. ACS Inc., 242 F.3d 1337, 1341 (Fed. Cir. 2001).

The term “expanded state” is explicitly mentioned in the specification (Page 12 lines 23-24) and is described to mean a fully expanded stent (Page 13 lines 13-14) capable of maintaining an acceptable radial strength and fatigue tolerance (Page 14 line 29) while properly scaffolding a vessel (Page 26 lines 17-18). In contrast the process described in Lau of using a tapered balloon is identified by and described in the specification as an “incomplete expansion” and lacks those characteristics which define an “expanded state”. (Page 16 lines 6-7). These constructions of the terms “expanded state” and “incomplete expansion” are not possible claim limitations but are in fact definitions required by the specification’s teaching of the claimed embodiments. Limitations from the specification are not read into the claims but required definitions are read into the claims. In re Van Geuns, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

The specification is explicit that there are only two manners of expanding a stent, fully expanding it into an “expanded state” or only performing an “incomplete expansion”. The above definition of an “expanded state” is not one possible limitation being read into the claims but is in fact the only possible manner of constructing the claims consistent with the specification. Because the specification explicitly distinguishes an “expanded state” from Lau’s “incomplete expansion”, the claimed “expanded state” cannot be understood in light of the specification to read on Lau. In addition neither Alt nor Limon describes a stent having a taper when in an “expanded state”. Because Lau, Alt, and Limon whether viewed individually or in combination do not describe Applicant’s claims, they cannot be the basis of a rejection under 35 U.S.C. §103(a).

6) Rejection of claim 49 under 35 U.S.C. §§ 102(e) and 103(a) by Goicoecha

The Office action stated that it was maintaining the rejection of claim 49 for the same reasons that it was rejected in the June 22, 2006 Office Action. Applicant respectfully notes that neither a rejection nor a reason for a rejection of claim 49 was provided in the June 22,

2006 Office Action.

Applicant however assumes that because claim 49 depends from claim 48, claim 49 must traverse the same basis of rejections applied to claim 48. As mentioned in section 4 of these remarks, instant claim 49 recites an annular element with a greatest tapered diameter having no more struts than the annular element with a narrowest tapered diameter. Nowhere in Goicoechea is this limitation disclosed. In addition to traversing Goicoechea, this amendment does not require a new search as this limitation has already been presented and searched for by claims 34-35, 37, 42-45, and 47 and this amendment merely limits the scope of already searched for material.

Conclusion

Based on the previous remarks, Applicant respectfully submits this application is in condition for allowance. Favorable consideration and prompt allowance of claims 34, 35, 37, 42-45, 47, and 48 are requested.

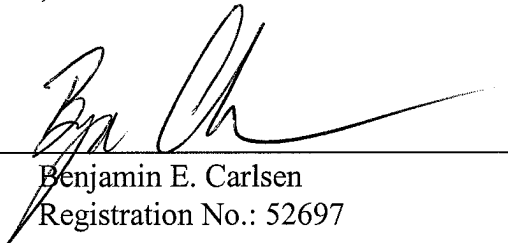
Should the Examiner believe that anything further would be desirable in order to place this application in better condition for allowance, the Examiner is invited to contact Applicant's undersigned representative at the telephone number listed below.

Respectfully submitted,

VIDAS, ARRETT & STEINKRAUS

Date: January 15, 2007

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